

REMARKS

Claims 1-21 remain in this application. Claims 1-6, 8, 9, 11-15, 17, 18 and 20 are rejected. Claims 7, 10, 16 and 19 are allowed. Claims 1, 2, 4, 8, 11 and 12 are amended herein to clarify the invention and to address matters of form unrelated to substantive patentability issues.

Applicants herein traverse and respectfully request reconsideration of the rejection of the claims and objection cited in the above-referenced Office Action.

Claims 1, 2, 4, 5, 11, 12, 14, 15, 17 and 20 (and 21) are rejected as obvious over Wagner et al. (US 5,517,957) in view of Kajihara et al. (US 5,607,240) under 35 U.S.C. §103(a). The applicants herein respectfully traverse this rejection. For a rejection under 35 U.S.C. §103(a) to be sustained, the differences between the features of the combined references and the present invention must be obvious to one skilled in the art.

It is respectfully submitted that a *prima facie* case of obviousness has not been established in rejection of claims 1, 2, 4, 5, 11, 12, 14, 15, 17, 20 and 21. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable

expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." MPEP §706.02(j) "Contents of a 35 U.S.C. §103 Rejection".

As noted by applicants in the previously amendment filed March 9, 2004, neither cited reference of the proffered combination teaches or suggests the provision of a retainer for a roller bearing which includes an annular portion facing to the side of a seal ring which has an outer diameter which is reduced in diameter with respect to a remaining diameter of the retainer thereby defining a step between the reduced outer diameter annular portion facing the seal and the diameter of a remainder of the retainer, so as to increase a storage volume for lubricating oil between the seal ring opposing the annular portion in an axial direction, as is claimed in each of the independent claims 1, 11 and 17.

Applicants believe that the reason for the Examiner's repeating of the rejection resides in a misunderstanding as to precisely what structure is being referred to by the recitations in the claims. In particular, the Examiner relies on the Kajihara et al. reference to provide alleged structure relating to a roller bearing in which a retainer includes a reduced outer diameter portion defining a step. While the structure being claimed in each of the independent claims is directed to the bearing

structure identified by example in the figures as roller bearing 5 (see Fig. 1), utilizing the retainer structure exemplified in Fig. 5, which, in stark contrast to using balls instead relies on rollers, the structure shown and described in Kajihara et al. is directed exclusively to a ball bearing. Therefore, the reference fails to provide teaching or suggestion of any reduced diameter portion of a specific retainer structure as claimed, which is applied to a roller bearing. Moreover, applicants further submit that no “step” *per se* is shown, as presently claimed. Rather, the portion identified as 5w-a depicts a sloped region which extends up to a greatest diameter of the retainer, and which tapers with respect thereto, forming instead a “chamfer” structure.

Thus, the combination of references fails to teach or suggest all the claim limitations as properly required to establish a *prima facie* case of obviousness. Therefore, reconsideration of the rejections of claims 1, 2, 4, 5, 11, 12, 14, 15, 17, 20 and 21 and their allowance are respectfully requested.

Claims 3, 13 and 18 are rejected as obvious over Wagner et al. (US 5,517,957) in view of Kajihara et al. (US 5,607,240), and further in view of Fujiwara (GB 2 330 884) under 35 U.S.C. § 103(a). The applicants herein respectfully traverse this rejection.

It is respectfully submitted that the Fujiwara (GB) reference fails to provide the teaching lacking in both Wagner et al. and Kajihara et al., as discussed above with regard to the independent claims from which these claims depend.

Furthermore, the Fujiwara reference fails to provide the teaching of a recess provided in an inner diametrical surface of a pulley, as discussed more fully below with regard to claim 8. Thus, the combination of references fails to teach or suggest all the claim limitations. Therefore, reconsideration of the rejection of claims 3, 13 and 18 and their allowance are respectfully requested.

Claim 6 is rejected as obvious over Wagner et al. (US 5,517,957) in view of Kajihara et al. (US 5,607,240), and further in view of Doi et al. (US 6,367,982) under 35 U.S.C. §103(a). The applicants herein respectfully traverse this rejection.

It is respectfully submitted that the Doi et al. reference fails to provide the teaching lacking in both Wagner et al. and Kajihara et al., as discussed above with regard to independent claim 1 from which this claim depends. Thus, the combination of references fails to teach or suggest all the claim limitations. Therefore, reconsideration of the rejection of claim 6 and its allowance are respectfully requested.

Claim 8 is rejected as obvious over Wagner et al. (US 5,517,957) in view of Kajihara et al. (US 5,607,240) and Fujiwara (GB 2 330 884) under 35 U.S.C. §103(a). The applicants herein respectfully traverse this rejection.

Claim 8 recites in pertinent part the provision of “a recess for increasing a storage volume for lubricating oil in said annular space [which] is provided in an inner diametrical surface of said pulley between said one-way clutch and said rolling bearing.” This recess is shown, for example, in Fig. 1 of the present application as

the reference numeral 1a. The Examiner provides an illustration (marked-up Fig. 7) alleged to show such structure, identifying the recesses used to reject the claimed subject matter. The structure shown (as a tapered portion) is clearly not formed in the “inner diametrical surface of said pulley,” but rather in the outer wheel 42 of the bearing itself (see page 9 of Fujiwara (GB)). The Examiner, in making the rejection, would appear to be broadly considering the bearing as being part of the pulley unit, and therefore considering the limitation of “an inner diametrical surface of said pulley” as having been met. However, applicants bring to the Examiner’s attention that what is being claimed is a recess provided in “an inner diametrical surface of said pulley”, not in said pulley unit. In this regard, a “pulley 1” is clearly distinguished from a “pulley unit A” in applicants’ disclosure (see page 8, lines 20-23). As such, what is being claimed is a recess formed directly in an inner surface of the pulley itself, i.e., the outer structural element only of the pulley unit about which a belt is wound, identified by example as the component designated by the numeral 1 in Fig. 1. Such element would be equivalent to the annular outer body 1 of Fujiwara (GB), in which no recess is shown or described. All other references are admittedly also silent regarding this claimed feature.

Thus, the combination of references fails to teach or suggest all the claim limitations as properly required to establish a *prima facie* case of obviousness. Therefore, reconsideration of the rejections of claim 8 and its allowance are respectfully requested.

While the Examiner has not commented on or repeated the prior rejection of claim 9, applicants will, for purposes of a full response, assume that claim 9 is again rejected as obvious over Wagner et al. (US 5,517,957) in view of Kajihara et al. (US 5,607,240) and Fujiwara (GB 2 330 884), and further in view of Doi et al. (US 6,367,982) under 35 U.S.C. §103(a). The applicants herein respectfully traverse this rejection.

It is respectfully submitted that the Doi et al. and Fujiwara references both fail to provide the teaching lacking in both Wagner et al. and Kajihara et al., as discussed above with regard to independent claim 1, from which this claim depends. Thus, the combination of references fails to teach or suggest all the claim limitations. Therefore, reconsideration of the rejection of claim 9 and its allowance are respectfully requested.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited. Please charge any deficiency or credit any overpayment to Deposit Account No. 10-1250.

Respectfully submitted,
JORDAN AND HAMBURG LLP

By C. Bruce Hamburg by:
C. Bruce Hamburg
Reg. No. 22,389
Attorney for Applicants

Jordan and Hamburg LLP
122 East 42nd Street
New York, New York 10168
(212) 986-2340

James D. Thiel
Reg No. 36,049